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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,529	04/02/2001	Jason Mitchell Streit	NI01US1	9418

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EXAMINER

SCHLAIFER, JONATHAN D

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/824,529

Applicant(s)

STREIT ET AL.

Examiner

Jonathan D. Schlaifer

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2001.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 02 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Art Unit: 2178

DETAILED ACTION

1. This action is responsive to application 09/824,529 filed on 4/2/2001, with no prior art filed.
2. Claims 1-20 are pending in the case. Claims 1, 15, 20 are independent claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 20 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. On lines 5-6, the term "right page" is used twice; it was not completely to the examiner what the distinguishing characteristic that makes a give page "right" would be. For purposes of examination, the term has been read as "right page for a given insertion".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1-3 and 5-8 is rejected under 35 U.S.C. 102(b) as being anticipated by Microsoft Corporation, Microsoft Word: User's Guide, 1993-1994, Microsoft Corporation, Version 6.0, hereinafter Microsoft Corporation.**

5. **Regarding independent claim 1**, Microsoft Corporation discloses an information item placement system (the document discloses a word processor) comprising: a document (p. 352 depicts a document); a plurality of information items (the document on p. 352 has information items on it); a location specification component (the user interacts with a mouse, which is inherent); and the location specification component facilitating the selective specification of placement information for the plurality of information items within the document (anchoring and moving components using the mouse is described on p. 352, see top paragraph)
6. **Regarding dependent claim 2**, Microsoft Corporation discloses a system wherein the plurality of information of information items selectively comprises signatures, images, dates, images text and / or logos (Microsoft Word was capable of manipulating text, as shown on p. 352 (see caption to figure at top of page)).
7. **Regarding dependent claim 3**, Microsoft Corporation discloses a system wherein the selectively specified placement information for the plurality of information items within the document is saved as part of the document (on pages 340-341, Microsoft Corporation discloses that the location is recorded (see top of p. 341), and hence saved, as part of the document).
8. **Regarding dependent claim 5**, Microsoft Corporation discloses a system wherein the location specification component is a document viewer software that displays the document and provides location specification means (on p. 340, Microsoft portrays Microsoft Word as a word processor that views documents and allows location specification).

9. **Regarding dependent claim 6**, Microsoft Corporation discloses a system wherein the location specification means comprises a drag-and-drop box drawing utility with optional box relocation features (on p. 340-341, the mouse is used to drag-and-drop the frames for relocation)
10. **Regarding dependent claim 7**, Microsoft Corporation discloses a system wherein the drag-and-drop box drawing utility captures the page number and x- and y-coordinates of a rectangular box drawn within a page to specify the placement of one of the plurality of information items in the document (on p. 345-353, Microsoft Corporation discloses how frames are positioned and used to specify the placement of the items they frame).
11. **Regarding dependent claim 8**, Microsoft Corporation discloses a system wherein placement information for the one of the plurality items in the document is selectively replaced by redrawing the rectangular box to specify a new location of the one of the plurality of information items in the document (on pages 340-341, resizing and repositioning a frame causes redrawing).
12. **Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Steele (USPN 5,884,056—filing date 12/28/1995).**
13. **Regarding independent claim 15**, Steele discloses an information item placement system (according to the Abstract, lines 1-5, it is a video browser) comprising: a document (according to the Abstract, lines 1-5, a video document is browsed); a plurality of information items that is selectively placed in the document (the video shots, item 52 of Fig. 7, satisfies this limitation); an Internet browser that is used to retrieve the document; (line 3 species that the browsing may be over the Internet/WWW); an

Internet-based location specification component that works in conjunction with the Internet browser (the Abstract specifies in lines 10-20 how points are used to specify the organization of the representations/thumbnail images); the Internet-based location specification component facilitating the viewing of the document when retrieved via the Internet browser (there is a control to do this, item 55 of Fig. 7), the Internet-based location specification component facilitating the selective specification of placement information for the plurality of information items within the document (the Abstract specifies in lines 10-20 how points are used to specify the organization of the representations/thumbnail images).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft

Corporation further in view of Krishna et al. (USPN 6,012,071—filing date 1/29/1997), hereinafter Krishna.

15. **Regarding dependent claim 4**, Microsoft Corporation fails to disclose a system wherein the selectively specified placement information for the plurality of information items with the document is saved separately from the document. However, Krishna discloses in col. 4, lines 35-50 a program that separates content from format. This offered the advantage that “the publisher need not edit the publication file every time the information in one

region needs to be updated or changed” (col. 4, lines 48-50). It would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated Krishna’s technique of saving placement information separately from the document into Microsoft Corporation’s invention so that “the publisher need not edit the publication file every time the information in one region needs to be updated or changed” (col. 4, lines 48-50).

16. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Corporation.

17. Regarding dependent claim 9, Microsoft Corporation discloses a system wherein placement information for each of the plurality of information items is expressed in terms of the x- and y- coordinates of its location within the associated page (on page 341, at top, the horizontal and vertical coordinates are stored). Microsoft Corporation fails to explicitly disclose storage a page number of an associated page where it occurs in the document. However, it was notoriously well known in the art at the time of the invention that storing the page number of objects in a layout environment is helpful because having this information available helps reconstruct the objects in an organized manner. It would have been obvious to one of ordinary skill in the art at the time of the invention to add the feature of storing page numbers of layout objects to Microsoft Corporation’s invention in order to help reconstruct the objects in an organized manner.

18. Claim 10-11, 13-14, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Corporation further in view of Case (USPN 4,358,671—filing date 6/24/1981).

19. **Regarding dependent claim 10**, Microsoft Corporation discloses how annotations are used, which can serve store a message digest that is computed selectively employing the contents of one or more of the other sections of the document in order to provide supplementary information about a document. However, Microsoft Corporation fails to disclose as system wherein the plurality of information items comprises one or more signatures and dates and wherein the document comprises: a plurality of original document content sections, an image signature and date coordinates section for saving the placement information of one or more signature and dates; and an associated image signatures and dates sections for saving one or more signatures and dates. Case discloses a system wherein the plurality of information items comprises one or more signatures and dates (the document is a check) and wherein the document comprises: a plurality of original document content sections (in Fig. 1, the document has multiple sections for entering information on the check), an image signature and date coordinates section for saving the placement information of one or more signature and dates (these sections are present in Figure 1); an associated image signatures and dates sections for saving one or more signatures and dates; (these sections are present in Figure 1). Case's innovations facilitate validation of secure documents. It would have been obvious to one of ordinary skill in the art at the time of the invention to have manipulated signatures and dates in the manner of Case in the invention of Microsoft Corporation in facilitate validation of secure documents.
20. **Regarding dependent claim 11**, Microsoft Corporation discloses that the plurality of original document content sections comprises a plurality of section of a document

originally created using a document editor (according to p. 340 the document sections were created in Microsoft Word, which is a document editor).

21. **Regarding dependent claim 13**, it modifies claim 10 with the limitations provided for by claims 6-9 and is rejected under similar rationale.
22. **Regarding dependent claim 14**, Microsoft Corporation discloses a system wherein placement information for each of the plurality of information items is selectively replaced by redrawing the rectangular box drawn on the associated page or by adjusting the value of the associated pair of x- and y- coordinates (on page 341, "Positioning a Frame" specifies that these are possible).
23. **Regarding independent claim 20**, Microsoft Corporation teaches a method of specifying placement information, the method of specifying placement information comprising: retrieving the document (opening a document is documented on page 27); navigating to the right page for a given insertion in the document (navigating through a document is documented on page 37); dragging and dropping a rectangular box on the right page (resizing out a box is documented on page 340); capturing the corresponding x- and y-coordinates of the rectangular box (storing coordinates is documented on page 341); saving the page number and the x- and y-coordinates as a placement information for one of the plurality of signatures and dates and associating the placement information with one of the plurality of signatures and dates (associating frames with content is documented on page 341. Microsoft Corporation fails to disclose specifying a content type for the location specified by the rectangular box as a signature or date; selectively associating a placeholder content for the rectangular box for display purposes. However,

Case discloses in the Abstract, lines 1-15 that a check is processed and shows what it looks like in Figure 1 and thereby teaches specifying a content type for the location specified by the rectangular box as a signature or date; selectively associating a placeholder content for the rectangular box for display purposes (these are necessary steps to process checks because they facilitate manipulation of key elements of checks in the validation process). It would have been obvious to one of ordinary skill in the art at the time of the invention to specify content type and associate placeholder content in the manner of Case in the context of Microsoft Corporation because they facilitate manipulation of key elements of checks in the validation process.

24. **Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Corporation further in view of Case, further in view of Colomb (USPN 4,345,276—filing date 8/29/1980).**
25. **Regarding dependent claim 12,** Microsoft Corporation and Case fail to disclose that the plurality of original document content sections comprises a plurality of scanned section of document. However, in lines 1-20 of the Abstract, Colomb, discloses that the documents manipulated by the document would have consisted of scanned content because this would have converted document content into digital form that can be easily manipulated. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used scanned document content in the manner of Colomb in Microsoft Corporation and Case because it would have consisted of digital form that can be easily manipulated.

26. Claims 16 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steele, further in view of Microsoft Corporation.

27. Regarding dependent claim 16, Steele fails to disclose a system further comprising: a drag-and-drop rectangular box drawing utility for drawing a rectangular box that specifies the coordinates of one of the plurality of information items; and the drag-and-drop rectangular box drawing utility facility selective relocation of the rectangular box that specifies the coordinates of one of the plurality of information items. However, Microsoft Corporation discloses a drag-and-drop rectangular box drawing utility for drawing a rectangular box that specifies the coordinates of one of the plurality of information items (see pages 340-341, users can drag and drop out to indicate frames); and the drag-and-drop rectangular box drawing utility facility selective relocation of the rectangular box that specifies the coordinates of one of the plurality of information items (see pages 340-341, as part of dragging and dropping, the frames can be relocated). It would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the drag-and-drop features of Microsoft Word into Steele because they would have provided a convenient and user-friendly means of allowing the user to manipulate information items within the context of Steele's invention.

28. Regarding dependent claim 18, Steele fails to disclose a document repository; and the information item placement system saving the document along with the specification of placement information for the plurality of information items in the document at the document repository as a template. However, Microsoft Corporation discloses a document repository (a word processor inherently stores its documents on some kind of

storage medium); and the information item placement system saving the document along with the specification of placement information for the plurality of information items in the document at the document repository as a template (Microsoft Corporation discloses the use of templates, which stores information about the document, on page 214). It would have been obvious to one of ordinary skill in the art at the time of the invention to have used a template and a document repository because it would have organized the placement information for efficient storage and facilitated said storage.

29. **Regarding dependent claim 19**, Steele fails to disclose a system further comprising the information item placement system facilitating the retrieval of the template; the information item placement system facilitating the population of the plurality of information items in the template creating a populated document; and the information item placement system facilitating the population of the plurality of information items in the template creating a populated document; and the information item placement system facilitating the storage of the populated document. However, Microsoft Corporation discloses a system further comprising the information item placement system facilitating the retrieval of the template (in pages 214-217, Microsoft Word maintains templates which manage the content of a document); the information item placement system facilitating the population of the plurality of information items in the template creating a populated document (in pages 214-217, Microsoft Word maintains templates which manage the content of a document); and the information item placement system facilitating the population of the plurality of information items in the template creating a populated document (in pages 214-217, Microsoft Word maintains templates which

manage the content of a document); and the information item placement system facilitating the storage of the populated document(in pages 214-217, Microsoft Word maintains templates which manage the content of a document). It would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the template management system of Microsoft Word into Steele because it provides an organized approach for storing documents, which would have facilitated managing and using complex documents.

30. **Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Steele, further in view of Microsoft Corporation, further in view of Chalstrom et al. (USPN 6,633,913 B1—filing date 8/24/1999), hereinafter Chalstrom.**
31. **Regarding dependent claim 17,** Steele discloses the Internet-based location specification component facilitating the selective specification of placement information for the plurality of information items within the document, as noted previously. (see claim 15). Steele and Microsoft Corporation fail to disclose a paper document, a scanner for scanning the paper document, and the Internet-based location specification component facilitating the creation of the document by the scanning of the paper document on the scanner. However, Chalstrom discloses in col. 2, lines 1-30 a Web-based scanning utility that satisfies all of the limitations of the claim. It would have been obvious to one of ordinary skill in the art at the time of the invention to have included a paper scanning component in the manner of Chalstrom in Steele and Microsoft Corporation because it would have provided a convenient means for obtaining useful data from a significant data source.

Art Unit: 2178

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


USPN 5,638,504 (filing date 3/29/1996)—Scott et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan D. Schlaifer whose telephone number is 703-305-9777. The examiner can normally be reached on 8:30-5:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JS


STEPHEN S. HONG
PRIMARY EXAMINER